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REMARKS

Claims 18-24 are pending in this application. Claims 18 and 22 are independent. Claim 29 has been added. Claims 18, 19 and 23 have been amended to correct misspellings.

Claims 18-24 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over AMD's Am79C830 FORMAC Plus as disclosed in "The SUPERNET 2 family for FDDI – 1991/1992 World Network Data Book" (hereafter "AMD") and in further view of US Patent Number 4,063,220 (for claims 18-21), issued to Robert M. Metcalf, *et al* on December 13, 1977 (hereafter "Metcalf"), US Patent Number 4,860,193 (for claims 22-24), issued to Steven R. Bentley, *et al* on August 22, 1989 (hereafter "Bentley"), US Patent Number 5,210,749 (for claims 23-24), issued to Farzin Firoozman, *et al* on May 11, 1993 (hereafter "Firoozman"), and US Patent Number 5,696,899 (for all pending claims), issued to George A. Kalwitz on December 9, 1997 (hereafter "Kalwitz").

Claim Rejections - 35 U.S.C. § 103(a)

Claims 18-21 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over AMD in light of Metcalf and Kalwitz. Applicants respectfully traverse this rejection.

Applicants respectfully note that the use of Kalwitz is not allowable because Kalwitz was filed after the effective priority date of the present application. Kalwitz was filed on and has a priority date of November 18, 1992. The present application has a priority date of July 2, 1992. The present application is a continuation in part of US Patent Application 09/028,088 filed on February 23, 1998, which is a continuation of US Patent Application 08/503,797 filed on July 18, 1995 (now US Patent 5,872,920), which is a continuation of US Patent Application 08/374,491 filed on January 17, 1995 (now US Patent 5,485,584) which is a divisional of US Patent Application 07/907,946 filed on July 2, 1992 (now US Patent 5,412,782).

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Applicants note that Kalwitz might be used in situations where it relates to new matter in a continuation in part application. However, that is not the case in this instance. Kalwitz is being used against the ethernet term of the claims, and ethernet is clearly part of the original disclosure. In fact, the title of the July 2, 1992 case is "Programmed I/O ethernet adapter with early interrupts for accelerating data transfer", clearly showing that ethernet is part of the original application.

But even if Kalwitz were available, it is not applicable. The Examiner uses Kalwitz to try to link FDDI to ethernet. But Kalwitz does not address FDDI, and never mentions the term. Kalwitz does mention Token Ring as a proper noun once in column 11. Token Ring, as a proper noun, refers to the Token Ring protocol defined by IEEE 802.5. FDDI does use a token passing mechanism in a dual-ring LAN, but is a very different protocol defined by ANSI Standard X3T9.5. As such, Kalwitz does not provide the linkage that the Examiner is looking for.

Furthermore, the Office Action uses Kalwitz to argue that "Ethernet and token ring such as FDDI are notoriously well known in the art at the time of the invention and can often be used together". Applicants respectfully traverse. Not only is Kalwitz after the time of the invention, but also teaches against the use of Ethernet and Token Ring together. Look to column 11 of Kalwitz:

network core services and utilities. File servers can connect to more than one LAN by using up to four network interface cards (preferably Ethernet or Token Ring connections). In these configurations, "bridging" or "backbone" services are provided between a plurality of LANs, as shown in FIG. 2, such that resources, including printers, can be shared "internet" i.e., from one LAN to another.

The language implies something new, as the term internet needs to be explained. Each of Ethernet and Token Ring are on separate network interface cards talking to separate networks. They are certainly not "often used together". Thus the Office Action lacks the linkage between AMD and Metcalf that the Examiner sought to build with Kalwitz.

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Furthermore, there is no motivation to combine AMD with Metcalf and with Kalwitz. AMD never mentions Ethernet and Metcalf never mentions FDDI. These are two independent and distinct protocols, with no motivation to combine or to exchange technologies.

Claim 22 stands rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over AMD in light of Bentley and Kalwitz. Applicants respectfully traverse this rejection.

First of all, Kalwitz is neither available nor applicable, as described above. Furthermore, Bentley can not properly be combined with AMD because Bentley is used in a different field. Bentley describes the internal bus architecture of a computer system, and is not in the field of communications. It is therefore highly unlikely that one using AMD would know about Bentley, without the instruction of the present patent application.

Claims 23 and 24 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over AMD in light of Bentley, Firoozman and Kalwitz. Applicants respectfully traverse this rejection.

As described above, Kalwitz is neither available nor applicable. There is no motivation to combine Bentley with the others. And here the Office Action believes that it would have been obvious to add in Firoozman. There is simply no motivation to combine four items to find the present invention. The use of four references in itself is proof that a 103 rejection is improper.

Because the Examiners thesis of the linkage between ethernet and FDDI is based on the inapplicable and improper usage of Kalwitz, and because there is no motivation to combine AMD and Metcalf or the other references, withdrawal of the rejection of claims 18-24 pursuant to 35 U.S.C. § 103(a) is hereby requested.

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CLAIM 29

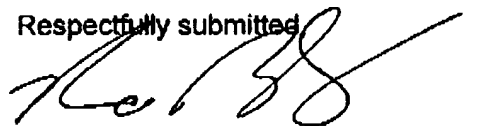
Claim 29 has been added based upon material found in the original application. No new matter has been added. Claim 29 is further distinct from the AMD, Kalwitz, Bentley, and Firoozman in that claim 29 contains elements not found in AMD, Kalwitz, Bentley, and Firoozman, and is thus allowable.

CONCLUSION

The pending claims define subject matter that is patentable, even in light of AMD, Metcalf, Bentley, Firoozman, and Kalwitz. The application is in condition for allowance. Applicants respectfully request prompt issuance of this application.

The commissioner is authorized to charge deposit account 503650 for any fees associated herein.

Respectfully submitted



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